

REMARKS

Claims 1-88 are pending in this application. The Examiner made a restriction requirement in this application, alleging that the pending claims fall into three groups:

Group I: Claims 1-34, directed to methods of performing RNA interference;
Group II: Claims 35-87, directed to double stranded polynucleotides; and
Group III: Claim 88, directed to a composition.

The Examiner asserted that Groups II and III are unrelated to Group I because the compositions of Groups II and III can be used as probes for identifying mRNA transcripts and such a method does not involve the methods recited in Group I. The Examiner opines that Groups II and III are unrelated because each group is drawn to a different compound or composition and, although the Examiner concedes that the compositions can be used for the same purpose, she asserts that the compositions involve different structural considerations, which results in the need for separate searches.

The Examiner also required an election of a single conjugate species. She indicated that claims 25, 39, 53, 67, 78, and 87 are drawn to many species of conjugates, and that claims 7, 17, 26, 40, 54, 68, and 79 specify cholesterol as a conjugate whereas claims 27, 41, 55, 69, and 80 specify polyethylene glycol as a conjugate.

Applicants respectfully disagree with the Examiner's requirement for restriction among claim groups, but provisionally elect Group II. Applicants also respectfully disagree with the requirement for election, but provisionally elect cholesterol as a conjugate. Claims 7, 17, 26, 40, 54, 68, 79 read on cholesterol as a conjugate.

Applicants submit that it would not pose an undue burden to examine the asserted claim groups together. For example, the claims of Groups II, and III each recite at least one 2' modification. Thus, a search for a double stranded polynucleotide comprising at least one 2'

modification should reveal references that could be cited against the claims of Group II and Group III. Further, any search for references relevant to the compositions of Group II and Group III would reveal references relevant to the methods of Group I, since the references from a Group II search would relate to double stranded polynucleotides that can be used in RNA interference with compositions comprising at least one 2' modification. Thus, searching the asserted claim groups together should not present the Examiner with an undue burden.

Should the Examiner decline to consider Groups I, II, and III together, Applicants submit that at least Group II and Group III should be examined together. Each claim of Group II, and the claim of Group III, requires at least one 2' modification that comprises an orthoester and/or at least one other 2' modification. Group II comprises claims that recite orthoester modifications, other 2' modifications, or a combination, whereas Group III consists of a claim that recites both an orthoester modification and other 2' modifications. As a result, any references that might be raised against the claims of Group II should also be relevant to the claim of Group III. Accordingly, Applicants request reconsideration and withdrawal of the restriction requirement or, in the alternative, inclusion of Group III within Group II.

Additionally, as noted above, Applicants respectfully disagree with the requirement for an election of conjugate. An election of species is appropriate when there is no disclosure of a relationship between species. MPEP 808.01(a). Here, the specification discloses a relationship between the asserted species. For example, the specification discloses that conjugates can increase stability and/or facilitate uptake of RNA (see, for example, the specification at page 14, line 22 to line 25). Thus, the asserted species share a functional relationship, and, accordingly, Applicants request reconsideration and withdrawal of the election requirement.

Should the Examiner not withdraw the required election of a species, Applicants request that the Examiner consider inclusion of "lipids" rather than "cholesterol" for election. Applicants submit that the term "lipids" conveys species that have both a structural and functional relationship. Those of ordinary skill in the art will be aware of the structural

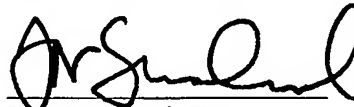
Applicant: LEAKE *et al.*
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relationship between “lipids,” and Applicants refer the Examiner to the arguments made of record above relating to the functional relationship between conjugates and, in this case, “lipid” conjugates. Accordingly, Applicants request that in the event that the election requirement is not withdrawn, the Examiner allow Applicants to elect “lipids” rather than “cholesterol.” If the Examiner agrees to election of “lipid” as a conjugate, Applicants will amend claims 25, 39, 53, 67, 78, and 87 to omit reference to conjugates that are not “lipid.”

If there are any questions or comments relating to this response, the Examiner is respectfully invited to contact Applicants’ attorney at the telephone number listed below.

No fee is believed to be due in connection with the filing of this Response . If any fees are deemed due, or an overpayment has been made, please charge, or credit, our Deposit Account No. 11-0171 for such sum.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tor Smeland', written over a horizontal line.

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